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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,978	02/02/2005	Hideki Kono	Q81601	3384

23373 7590 11/09/2006

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EXAMINER	
HU, HENRY S	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/501,978	KONO ET AL.	
	Examiner	Art Unit	
	Henry S. Hu	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Pre-Amendment of September 20, 2005*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-17* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. This application **10/501,978** is **a CIP of 10/046,702, now US Patent No. 6,743,508**. It is noted that USPTO has received **two IDS'** filed on July 16, 2004 (1 page) and November 18, 2004 (2 pages) respectively. The office action is in response to **two Pre-Amendments** filed on September 20, 2005 and July 14, 2004 respectively. **Claims 1-17** with a total of **two** independent claims (Claim **1** and Claim **9**) are now pending. An action follows.

DETAILED ACTION

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted as following:

I. **Claims 1-8 and 15-17**, drawn to an FEP pellet with three specified properties, classified in class 526, subclass 250.

II. **Claims 9-14**, drawn to a **different FEP pellet** with **some functional group(s) on end group** of terpolymer of TFE/HFP/PAVE, classified in class 526, subclass 247.

3. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "**special technical features**" shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, **makes over the prior art**. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons:

in view of the references cited in the allowed parent case **10/046,702, now US Patent No. 6,743,508** in comparison with international search report for **PCT/JP03/00370 (WO 03/059969), Claims 1-8 and 15-17 (Group I) and Claims 9-14 (Group II)** is either obvious or anticipated by any one of the following: **US 4,626,587, US 4,029,868, US 5,677,404 and US 5,703,185**, each individually or in combination. In summary, these two groups have no common features in the preparation as well as its application since they are structurally different at least on terminus group. The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions, making PFEP pellets from

Group I or Group II does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate.

With respect to the fact that "they are structurally different", Group I was drawn to an FEP pellet with three specified properties while Group II was drawn to a **different FEP pellet** with **functional group(s) (which is selected from the group consisting of many different species) as end group** of terpolymer of TFE/HFP/PAVE. It is found that the functional group(s) as end groups in terpolymer of Group II will certainly behave quiet different from FEP terpolymer of Group I, which is not necessarily containing such functional group(s). The process of making and the process of using are thereby different and unique.

4. Because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. It is noted that a phone call was made to **Abraham J. Rosner (tel: 202 293-7060)** on November 6, 2006 by the examiner; Attorney has requested a written letter. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The **fax** number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

November 6, 2006

DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700